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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

APPLICANT: Peter POST et al GROUP ART UNIT: 3629
SERIAL NO.: 09/522,619 EXAMINER: Naresh Vig
FILED: March 10, 2000 CONFIRMATION NO.: 5081
TITLE: "METHOD FOR PROTECTING A SECURITY MODULE AND ARRANGEMENT FOR THE IMPLEMENTATION OF THE METHOD"

MAIL STOP APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SIR:

A Notification of Non-Compliant Appeal Brief was mailed on June 6, 2005, stating that the Appeal Brief filed March 17, 2005 is defective because claim 2, which was cancelled in an earlier Amendment, is not listed as "Claim 2 (Cancelled)" in the list of claims.

The Notification was sent pursuant to 37 C.F.R. §1.41.37, however, as Applicants have previously noted, the present appeal was filed before that rule went into effect, and therefore is governed by 37 C.F.R. §1.192, that was in effect at the time the Brief was filed. Nevertheless, the respective sections of 37 C.F.R. §1.192 and 37 C.F.R. §1.41.37 regarding the content of the Appendix are identical. Each of those subsections requires that the claims appendix contain "a copy of the claims involved in the Appeal" (emphasis added). Claim 2, as noted by the Examiner, was cancelled during earlier prosecution and therefore is *not* involved in the present Appeal, and therefore it would have been improper to include claim 2 in the original Appendix, and it would be improper to file a substitute Appendix in which claim 2 is

included. The Appendix for the claims that must be attached to the Appeal Brief is not the same as the format of claims that must be presented in an Amendment.

The undersigned counsel for the Applicants has filed several hundred Appeal Briefs under the previous rules and the current rules and has never been required by an Examiner or by the Board to include a copy of a cancelled claim in the claims Appendix.

Applicants cannot respond to the present Notification in a manner that would make their Brief non-compliant, rather than compliant, with the applicable rules. Applicants submit the Appeal Brief that was filed on March 17, 2005 is fully compliant with former 37 C.F.R. §1.192 (9) as well as current 37 C.F.R. §1.41.37(c)(1)(viii).

Submitted by,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 24, 2005.

Steven H. Noll

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